

REMARKS

Claims 1-19, and 21-30 are currently pending in the application. Only claims 1 and 21 are in independent form.

The Office Action states that the application does not include an Abstract of the Disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet of paper is enclosed herewith and reconsideration of the objection is respectfully requested.

Claim 28 is objected to because of informalities. These informalities have been amended herewith and reconsideration of the rejection is respectfully requested.

Claims 20 and 21-30 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Office Action states that claim 20 includes a phrase that does not further limit the claimed invention. Claim 20 has been canceled without prejudice thereby rendering the present rejection moot. Reconsideration of the rejection is respectfully requested.

Regarding claim 30, the Office Action states that the phrase "comprises operating a clamp to move first and second clamping member" is unclear. Claim 30 has been amended to recite, "comprises operating a clamping mechanism for moving first and second clamping members." Reconsideration of the rejection is respectfully requested.

Claims 1-7 and 20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the Dean patent. Reconsideration of the rejection under 35 U.S.C. § 102(b), as anticipated by the Dean patent, as applied to the claims is respectfully requested. Anticipation has always been held to require absolute identity in structure between the claimed structure and a structure disclosed in a single reference.

In Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 231 U.S.P.Q. 81 (Fed. Cir. 1986) it was stated: "For prior art to anticipate under §102 it has to meet every element of the claimed invention."

In Richardson v. Suzuki Motor Co., Ltd., 868 F.2d 1226, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989) it was stated: "Every element of the claimed invention must be literally present, arranged as in the claim."

The Office Action states that the Dean patent discloses an apparatus for moving a container such that the container is rotated relative to the frame and rolled along a surface. However, when read more specifically, the Dean patent discloses a garden roller that utilizes sockets to enable a roller to be attached to stems. There is no disclosure for clamping the roller between the stems. More specifically, the system of the Dean patent could not function properly if merely clamped into place because a water supply is connected to the interior of the drum. Water is then added to the drum and subsequently dispersed from the drum onto the desired location. The Dean patent does not disclose or suggest an apparatus having a mechanism for clampingly holding a container such that the container can be then rolled along a surface. Instead, the Dean patent discloses a device for connecting a drum to stems. Further, the container involved in the Dean patent is not held in a clamping engagement with the stems, but instead is directly connected to the stems. In contradistinction, the presently pending independent claims claim a device for clampingly holding a container while enabling the container to be rolled. The Dean patent neither suggests nor teaches the apparatus of the presently pending independent claims. The claims are therefore patentable over the Dean patent and reconsideration of the rejection is respectfully requested.

Claims 21-28 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the Dean patent. Reconsideration of the rejection under 35 U.S.C. § 102(b), as anticipated by the Dean patent, as applied to the claims is respectfully requested. Anticipation has always been held to require absolute identity in structure between the claimed structure and a structure disclosed in a single reference.

The Office Action states that the method of the Dean patent includes steps of fixing a frame to a roller or a container and rotating the container relative to the frame. However, when read more specifically, the Dean patent discloses a garden roller that utilizes sockets to enable a roller to be attached to stems. There is no disclosure for clamping the roller drum between the stems. Further, the system of the Dean patent would not function properly if a clamping engagement were used because a water supply is connected to the interior of the drum and therefore the connection cannot merely be made via a clamp but instead must involve a fluid connection. The apparatus of the Dean patent thus does not disclose or suggest a container that can then be rolled along a surface. Instead, the Dean patent discloses a device for connection to a container that forms a single a unit. Further, the container is not held in a clamping engagement with the stems, but is instead directly connected to the stems. In contradistinction, the presently pending independent claims claim a device for clampingly holding a container while enabling the container to be rolled. Therefore, the Dean patent neither suggests nor teaches the apparatus of the presently pending independent claims, the claims are patentable over the Dean patent, and reconsideration of the rejection is respectfully requested.

Claims 8-11 and 30, stand rejected under 35 U.S.C. §103(a) as obvious over the Dean patent in view of the Henderson et al. patent. Reconsideration of the rejection under 35 U.S.C. §103(a) over the Dean patent in view of the Henderson et al. patent, as applied to the claims is also respectfully requested.

It is Hornbook Law that before two or more references may be combined to negative patentability of a claimed invention, at least one of the references must teach or suggest the benefits to be obtained by the combination. This statement of law was first set forth in the landmark case of Ex parte McCullom, 204 O.G. 1346; 1914 C.D. 70. This decision was rendered by Assistant Commissioner Newton upon appeal from the Examiner-in-Chief and dealt with the matter of combination of references. Since then many courts have over the years affirmed this doctrine.

The applicable law was more recently restated by the Court of Appeals for the Federal Circuit in the case of ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929 (Fed. Cir. 1984). In this case the Court stated, on page 933, as follows:

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under Section 103 teachings of references can be combined only if there is some suggestion or incentive to do so. The prior art of record fails to provide any such suggestion or incentive. Accordingly we hold that the court below erred as a matter of law in concluding that the claimed invention would have been obvious to one of ordinary skill in the art under section 103.

This Doctrine was even more recently reaffirmed by the CAFC in Ashland Oil, Inc. v. Delta Resins and Refractories, Inc., et al., 776 F.2d 281, 297, 227 U.S.P.Q. 657,667. As stated, the District Court concluded:

Obviousness, however, cannot be established by combining the teachings of the prior art to produce the claimed invention unless there was some teaching, suggestion, or incentive in this prior art which would have made such a combination appropriate.

The Court cited ACS Hospital Systems, Inc. in support of its ruling. This Doctrine was reaffirmed in In re Deuel, 34 USPQ2d 1210 (Fed. Cir. 1995).

The Office Action states that the Dean patent discloses the clamping members, but fails to show the clamping members that can be moved toward each other. However, when read more specifically, the Dean patent discloses a garden roller that utilizes sockets to enable a roller to be attached to stems. There is no disclosure for clamping the roller between the stems. More specifically, the system of the Dean patent could not function properly if merely clamping into place because a water supply is connected to the interior of the drum. The water is then added to the drum and

subsequently dispersed from the drum onto the desired location. The apparatus of the Dean patent does not disclose or suggest an apparatus having a mechanism for clampingly holding a container such that the container can be then rolled along a surface. Instead, the Dean patent discloses a device for connecting a drum to stems. Further, the container is not held in a clamping engagement with the stems, but is instead directly connected to the stems. In contradistinction, the presently pending independent claims claim a device for clampingly holding a container while enabling the container to be rolled. The Dean patent neither suggests nor teaches the apparatus of the presently pending independent claims, the claims are patentable over the Dean patent and reconsideration of the rejection is respectfully requested.

The Office Action states that the Henderson et al. patent discloses an apparatus for transporting a tank and other diving gear. The apparatus includes a frame that has a handle section and a roller. The roller includes a metal rod about which a plastic tube and roller rotate. Thus, the roller functions as a wheel, and later buoyant device, but does not enable the roller to be removed and added or to be exchanged for a different piece of material. There is no disclosure for an apparatus that clampingly holds a device within the arms of the clamping device while permitting the device to be rolled. This is distinctly different than the device of the presently pending independent claims, which instead claim a device for clamping a container therebetween without requiring an axle. Since neither the Dean nor the Henderson et al. patents, either alone or in combination, disclose nor suggest the method and device of the presently pending independent claims, the claims are patentably over the Dean and Henderson et al. patents. Reconsideration of the rejection is respectfully requested.

The remaining dependent claims not specifically discussed herein are ultimately dependent upon the independent claims. References as applied against these dependent claims do not make up for the deficiencies of those references as discussed above. The prior art references do not disclose the characterizing features of the independent claims discussed above. Hence, it is respectfully submitted that all of the pending claims are patentable over the prior art.

USSN: 10/049,354
Attorney Docket No: 3120.00030

In view of the present amendment and foregoing remarks, reconsideration of the rejections and advancement of the case to issue are respectfully requested.

The Commissioner is authorized to charge any fee or credit any overpayment in connection with this communication to our Deposit Account No. 11-1449.

Respectfully submitted,

KOHN & ASSOCIATES, PLLC



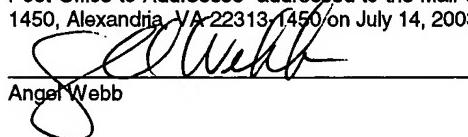
Amy E. Rinaldo
Registration No. 45,791
30500 Northwestern Highway
Suite 410
Farmington Hills, Michigan 48334
(248) 539-5050

Dated: July 14, 2003

CERTIFICATE OF MAILING

EXPRESS MAIL LABEL: EV338883309US

I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" addressed to the Mail Stop Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on July 14, 2003.


Angel Webb